

Application No.: 09/934031

Case No.: 56091US002

Remarks

The Office Action dated October 21, 2003 has been received and reviewed. Claims 7-8 and 35 have been amended. The pending claims are claims 1-2, 4-8, 10-13, 15-28, 30-33, and 35-37. Reconsideration and withdrawal of the rejections are respectfully requested.

The Claim Amendments

Claims 7-8 were amended to correct typographical errors.

Claim 35 was amended to recited that the retroreflective beads include a coating including aluminum. No new matter was added.

The 35 U.S.C. § 102(b) Rejection

Claim 35 was rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshitaka (Japanese Patent No. 3,193,440). Applicants traverse this rejection.

However, to further move this case towards issuance, Applicants have amended claim 35 to recite that the retroreflective beads include a coating including aluminum. Applicants submit that Yoshitaka does not teach all of the elements of amended claim 35.

For a claim to be anticipated under 35 U.S.C. § 102(b), each and every element of the claim must be found in a single prior art reference. *See* M.P.E.P. § 2131. In contrast to amended claim 35, Yoshitaka teaches a reflective sheet having a foamed layer 14 and an adhesive layer 11 on the front surface of the foamed layer 14. *See* Yoshitaka, page 1, first paragraph. Glass beads 13 are dispersed and adhered to the foamed layer 14, e.g., using the adhesive layer 11. *Id.* The reflective sheet can be used as a decorative sheet material. *Id.* at page 5, first paragraph. Yoshitaka does not teach that the glass beads 13 have a coating that includes aluminum. Because Yoshitaka does not teach each and every element of amended claim 35, such claim is not anticipated by Yoshitaka.

For at least the above reasons, Applicants submit that claim 35 is not anticipated by Yoshitaka. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Application No.: 09/934031

Case No.: 56091US002

The 35 U.S.C. § 103(a) Rejections

Claims 1-2 and 4-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carte et al. (U.S. Patent No. 5,947,917) in view of Lightle et al. (U.S. Patent No. 5,128,804).

Applicants traverse this rejection and submit that claims 1-2 and 4-8 are not *prima facie* obvious for at least the following reasons. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Applicants submit that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See M.P.E.P. § 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

For example, Carte et al. teaches a water resistant, flexible, dermal adhesive product for conformable topical application to human skin. See Carte et al., Abstract. Carte et al. further teaches that the product can be an adhesive bandage or a medical tape. The medical tape includes a backing 12 and adhesive 14. See, e.g., *id.* at FIG. 2. For the adhesive bandage, Carte et al. teaches a backing or facestock 12 having coated on one surface thereof a self adhesive or pressure-sensitive adhesive layer 14 which is protected by release liner segments 16 and 18 and which supports an absorbent pad or gauze 20. See *id.* at column 3, lines 26-30. However, as admitted by the Office Action, Carte et al. does not teach a layer of retroreflective beads that are partially embedded in the non-adhesive side of a tape as recited, e.g., independent claim 1 of the present invention. In fact, Carte et al. is silent regarding retroreflective articles.

Application No.: 09/934031

Case N.: 56091US002

Further, Lightle et al. teaches a flexible, self-supporting, air-permeable retroreflective sheeting that includes a two-sided, self-supporting, air-permeable web of thermoplastic filaments with retroreflective elements partially embedded in the filaments on one side of the web. See Lightle et al., Abstract. On the other side of the web, the surfaces of the filaments are substantially free of reflective elements. *Id.* Lightle et al. further teaches that the web may be used as a bonding agent to secure the sheeting to a desired substrate. *Id.* Lightle et al., on the other hand, does not teach or suggest partially embedding retroreflective elements in a medical tape or adhesive bandage such as those taught by Carte et al. Without some teaching, suggestion, or motivation to combine the teachings of Carte et al. with those of Lightle et al. either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, such references cannot be combined to render claims 1-2 and 4-8 of the present invention *prima facie* obvious.

Further, the Office Action has failed to meet its burden for showing *prima facie* obviousness. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

Here, the Office Action alleges that one of skill in the art would combine the teachings of Carte et al. with those of Lightle et al. in order to make material "that has a level of retroreflective brightness over a wide range of angles as taught by Lightle et al." Applicants traverse this allegation. Applicants submit that the Office Action does not provide a convincing line of reasoning why one skilled in the art would combine the teachings of Carte et al. with those of Lightle et al. to produce the present invention as claimed in claims 1-2 and 4-8. Arguing that embedding retroreflective beads in a surface of a material taught by Carte et al. to make material that "has a level of retroreflective brightness over a wide range of angles" does not explain why one skilled in the art would either a) select the articles taught by Carte et al. to begin with, or b) modify the teachings of Carte et al. when Carte et al. is silent regarding retroreflective articles. Absent a

Application No.: 09/934031

Case No.: 56091US002

convincing line of reasoning why such combination would be made by one of skill in the art, a *prima facie* case of obviousness cannot be supported.

For at least the above reasons, Applicants submit that claims 1-2 and 4-8 are not *prima facie* obvious in view of the cited references. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claims 1-2, 4, 6-8, and 35-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over May (U.S. Patent No. 4,648,689) in view of Yoshitaka.

Applicants traverse this rejection and submit that claims 1-2, 4, 6-8, and 35-37 are not *prima facie* obvious in view of the cited references because there is no teaching, suggestion, or motivation to combine the teachings of May with those of Yoshitaka to produce the present invention as recited in claims 1-2, 4, 6-8, and 35-37. For example, May teaches pavement marking tape that includes an elastomeric body 2 having an adhesive layer 3 attached to the base of the body 2 and reflecting material 4 attached to the top surface of the body 2. See May, column 3, lines 33-40. May further teaches that the reflecting material 4 is preferably a thin retroreflective sheet including a polymeric support sheet in which a monolayer of transparent microspheres or beads are embedded. See *id.* at column 3, lines 44-47. The reflector support sheet has a layer of adhesive on the back by which it is adhered to the body 2. See *id.* at column 3, lines 49-52. In other words, May teaches that the microspheres are embedded in a polymeric support sheet that is then adhered to the body 2.

The Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a layer of retroreflective beads with an aluminum coating that are embedded in a surface in May in order to get better adhesion of the beads to the surface so that they do not fall off as taught by Yoshitaka.

Applicants traverse this alleged motivation. As stated above, May teaches microspheres that are embedded in a polymeric support that is then adhered to a foam body. There is no motivation or suggestion that the microspheres taught by May should be embedded in the foam body. Nor is there any suggestion or motivation to embed the polymeric support sheet into the foam body of May. Absent a motivation to modify the teachings of May with those of Yoshitaka, the combination of such references cannot render claims 1-2, 4, 6-8, and 35-37 *prima facie* obvious.

Application N .: 09/934031

Case No.: 56091US002

Further, the Office Action's alleged motivation to combine the teachings of May with those of Yoshitaka fails to provide a convincing line of reasoning for such a combination. For example, the Office Action alleges that one skilled in the art would be motivated to combine the teachings of May with those of Yoshitaka to "get a better adhesion of the beads to the surface so that they do not fall off as taught by Hokusin" is unsupported by either May or Yoshitaka. For example, Yoshitaka does not teach that embedding beads in a elastomeric body provides better adhesion than embedding beads in a polymeric support sheet and then attaching the sheet to an elastomeric body as is taught by May. Absent a convincing line of reasoning to combine such references, the Office Action cannot meet its burden for *prima facie* obviousness.

For at least the above reasons, Applicants submit that claims 1-2, 4, 6-8, and 35-37 are not *prima facie* obvious in view of the combination of May and Yoshitaka. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claims 10-13 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshitaka in view of Lightle et al.

Applicants traverse this rejection and submit that claims 10-13 are not *prima facie* obvious because there is no suggestion or motivation to combine the teachings of Yoshitaka with those of Lightle et al. to produce the present invention as recited in claims 10-13. For example, as stated above in regard to the 35 U.S.C. § 102(b) rejection of claim 35, Yoshitaka does not teach an article having a layer of retroreflective beads. Further, there is no suggestion or motivation in Yoshitaka to modify the described article such that it include retroreflective beads.

Further, Lightle et al. teaches that the reflective elements 12 are embedded in an air-permeable web 14 that is made of thermoplastic filaments 13. See, e.g., Lightle et al., column 5, lines 12-16. Lightle et al. does not teach a foam layer as is taught in Yoshitaka. Therefore, one skilled in the art would not be motivated to combine the teachings of Yoshitaka with those of Lightle et al.

For at least the above reasons, Applicants submit that claims 10-13 are not *prima facie* obvious in view of the cited references. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Application No.: 09/934031

Case N .: 56091US002

Claims 23-28 and 30-33 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over May in view of Yoshitaka and further in view of Lightle et al.

Applicants traverse this rejection and submit that claims 23-28 and 30-33 are not *prima facie* obvious because there is no suggestion or motivation to combine the cited references to produce the present invention. For example, as described above, there is no motivation or suggestion to modify the teachings of May with those of Yoshitaka such that beads are embedded in a foam backing. The addition of Lightle et al. does nothing to cure this deficiency already present in May.

For at least the above reasons, Applicants submit that claims 23-28 and 30-33 are not *prima facie* obvious in view of the cited references. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Summary

It is respectfully submitted that the pending claims are in condition for allowance. Reconsideration and withdrawal of all rejections are respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

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Date

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